

REMARKS

The above Amendments and these Remarks are in reply to the Office action mailed May 7, 2003.

I. Summary of the Examiner's Rejections

Claims 32-38, 40-50, 52-60 and 62-64 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Davies et al.* (U.S. patent No. 5,913,907), and further in view of *Krause* (U.S. patent No. 5,950,206).

Claims 39, 51 and 61 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Davies et al.* (U.S. patent No. 5,913,907), and further in view of *Krause* (U.S. Patent No. 5,950,206) as applied to the claims above, and further in view of *Burfield* (U.S. Patent No. 6,363,362).

II. Remarks

It is respectfully submitted that: (1) one of average skill in the art would not combine the references as alleged by the Examiner; and (2) the references, even if combined, do not teach one of average skill in the art the invention as defined in the claims.

In the previous response, Applicant set forth three positions: (1) that no prima facie rejection of the claims under 35 USC Section 103 was set forth; (2) that the motivation to combine the references was not present either expressly or inherently in the references; and (3) even when combined, the references wholly fail to render obvious to one of average skill in the art the claimed invention.

In the remarks in response to the rejection, the Examiner has only addressed two of the four features which applicant set forth with respect to the third position asserted by the Applicant. The

assertions by the Applicant that the motivation to combine the references was not addressed by the Examiner.

Contrary to the assertion by the Examiner, Applicant is not attacking the references individually; rather, the references lack the fundamental teachings such that, even if combined, would lead to the invention as defined in the present claims. The Examiner cited *In re Keller* for the proposition that one "... cannot show non-obviousness by attacking references individually where as here the rejection are based on combination of references" (Office Action, page 9).

In addition, Keller is factually distinct from the present situation. In Keller,

Appellant does not argue that any features of the rejected claims other than the use of digital timing are not disclosed in Keller and Berkovits. Thus, the sole issue regarding the prior art rejections is essentially whether the references, taken collectively, would have suggested the use of digital timing in a cardiac pacer to those of ordinary skill in the art at the time the invention was made. N642 F. 2d, 413, 424.

However, applicant respectfully asserts that the rejected features are not shown in the references such that, even if combined, they do not render the invention obvious to one of average skill in the art.

A. There is no Motivation to Combine the References.

The Examiner's asserted motivation to combine the features of the references, which for both combining *Davies* with *Krause* and *Davies*, *Krause* and *Burfield* is exactly the same, ("... to expand the utility of the *Davies* system and thereby increase the usable market share..." (Office Action page 3. and page 8) is no more than a broad conclusory statement. As noted by the Federal Circuit, when citing the Keller case:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. ... Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there

must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. [citations omitted]

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. ...[citations omitted] **The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.** See *In re Keller*, 642 F.2d 413, 425, 208 U.S.P.Q. (BNA) 871, 881 (CCPA 1981) (and cases cited therein). Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. See *Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q.2D (BNA) at 1617. **Broad conclusory statements standing alone are not "evidence."** *Id.* *In Re Werner Kotzab*, 217 F.3d 1365; 55 U.S.P.Q.2D 1313.

motivation?

There is no motivation to combine the references as suggested by the Examiner because the references are addressing entirely different problems.

Davies discloses a system for accessing distributed information, but the information accessed is all in the same format: HTML. There is no teaching in the system of integrating application data from a "... first type of data for the construction project input by an application program of at least a first type ..." and a "... second type of data for the construction project input by an application program of at least a second type ...".

Krause, on the other hand, teaches a construction project search system that was to be used by members only. The specification provides that only those individuals interested in accessing information are provided with user Ids and passwords. The search is limited to the construction projects database 44. The system is therefore not designed to access different types of information,
or even different databases or data types.

Davies is concerned with integrating data from a wide variety of sources. *Krause* is concerned with allowing a wide variety of clients running the same software to access a central database of construction data.

Krause's data is centralized and secure, while *Davies'* is provided on ISP file servers in HTML format. There is no motivation in *Krause* to combine its teachings with *Davies* and there is no need find information from widely distributed sources.

Hence, there is no motivation present in either reference which would lead one of average skill in the art to make and use the invention as defined in claims 32 – 64. *ordinary*

B. Even If The References Are Combined, The Invention Is Not Obvious.

Even were the motivation to combine the references present, the combined references would fail to render the invention as defined in the pending claims obvious to one of average skill in the art.

Independent Claim 33

Claim 33 includes features not disclosed by the combination of the references. Hence, even were one of average skill motivated to combine the teachings of the references, the person of average skill would not be led to the present invention. In particular, Claim 33 calls for:

receiving a first type of data for the construction project input by a first application program of at least a first type running on a first computer system to a central database;

receiving a second type of data for the construction project input by a second application program of *at least a second, different type* running on a second computer system to said central database; (Emphasis supplied).

There is no teaching of receiving “a first type of data... input by a first application program” in the cited prior art, combined with “...receiving a second type of data ... input by a second application program of at least a second, different type”. The Examiner states the first type of data is shown at “Fig1, step 405, step 425 *Davies.*” The specification of *Davies* makes clear that (1) elements 405 and 425 are not steps; (2) elements 405 and 425 are computers or workstations (col. 3, line 25) and file servers (col. 3 line 33). There is no disclosure of “a first application program” with “a first type of data”.

The Examiner states that “a second type of data is disclosed at “...Fig 2, step 405, column 4, lines 26 – 28 *Davies*; column 3 lines 26 – 35 *Krause*.” The ONLY application program disclosed in the document is “Netscape or Mosaic”, both of which teach the same application data:

Source text is provided in a “HyperText” Markup Language (*HTML) tags (step 5605) (Col 4, lines 39 – 42).

This feature has been further specified by the limitation calling for:

said first type and second type of application program comprise at least one of a computer aided design software application, a design database application, a procurement application, a facilities management application, or an accounting application.

The Examiner has taken the position that, with respect to claims 38 and 49 *Krause* discloses a computer aided design application, and, as understood by the Applicant, that one would combine this application with the *Burfield* reference to use an accounting application. However, the claim calls for the first and the second application data to be “different”.

There is no teaching of incorporating different types of application data as specified in claim 33, nor of the particular types of application software specified therein.

As noted above, *Davies* searches for distributed information in a single format. Hence, *Davies* searches for a single type of data. To allow *Davies* to search for such data, such information must be in a common format. Combining *Davies* with *Krause* would require that *Davies* search system access information which is secure (by a username and password, as taught by *Krause*), in a format not native to the format it normally uses to search data, and to search for information which it is not designed to search for – construction bidding information.

Combining the teachings would require additional modifications not taught or suggested by *Davies* or *Krause*, such as the ability to access the secure data of *Krause* or the ability to access data in formats other than HTML.

Finally, there is no suggestion of using applications such as “a computer aided design software application, a design database application, a procurement application, a facilities management application, or an accounting application in the references.”

Hence, a combination of *Davies* with *Krause* cannot support any rejection of claim 33 under 35 U.S.C. §103 as the references do not disclose all the elements of the claimed invention even when

combined. Hence, claims 32 – 37 and 40 – 44 are likewise not obvious. Reconsideration of claims 32 – 37 and 40 – 44 is therefore requested.

Independent Claim 45

Further, it is respectfully submitted that the invention as defined in claim 45, and dependent claims 46 – 52 is not obvious. Claim 45 requires:

first and second computer systems in data communication with the first and second interface databases, respectively;

wherein the first interface database is configured to store first type of data received from the first computer system running a first software application of at least a first type;

wherein the second interface database is configured to store second type of data received from the second computer system running a second software application of at least a second type;

wherein said first type and second type of application program comprise at least one of a computer aided design software application, a design database application, a procurement application, a facilities management application, or an accounting application (emphasis supplied).

Again, were *Davies* and *Krause* combined, there is no first and second type of application.

At best, *Krause* shows a CAD application, and *Davies* a web browser and search agent application.

The Search agent and web browser both have the same type of data.

Hence, a combination of *Davies* with *Krause* cannot support any rejection of claim 45 under 35 U.S.C. §103 as the references do not disclose all the elements of the claimed invention even when combined. Hence, claims 46 – 48, 50 and 52 are likewise not obvious. Reconsideration of claims 46 – 48, 50 and 52 is therefore requested.

Independent Claim 53

Further, it is respectfully submitted that the invention as defined in claim 53, and dependent claims 54 is not obvious. Claim 53 requires:

first and second computer systems, said first computer system including a first application software and said second computer system including a *second, different type of application software*, respectively, in data communication with the first and second interface databases, respectively;

wherein *said first type and second type of application program comprise at least one of a computer aided design software application, a design database application, a procurement application, a facilities management application, or an accounting application* (emphasis supplied).

As noted above, combining the teachings of the searching capability of *Davies* with the construction database of *Krause* would not be obvious to one of average skill in the art. *Davies* is designed to review public documents; the construction information in *Krause* is provided in a secure environment.

The combination of *Davies* with *Krause* cannot support any rejection of claim 53 under 35 U.S.C. §103 as the references do not disclose all the elements of the claimed invention even when combined. Hence, claims 53 and 54 are likewise not obvious. Reconsideration of claims 53 and 54 is therefore requested.

Independent Claim 55

Further, it is respectfully submitted that the invention as defined in claim 55, and dependent claims 56 – 58 and 60 - 64 is not obvious. Claim 55 requires:

storing first data received from a first computer system in a database, *wherein the first computer system operates at least a first type of application software and provides computer aided design data comprising construction project objects of a first type;*

transmitting the first message to a second computer system, wherein the second computer system is in data communication with the host computer system and the database *and operates at least a second type of application software providing construction project objects of a second type, wherein said and second type of application program comprises at least one of a design database application, a procurement application, a facilities management application, or an accounting application;* (emphasis supplied)

As noted above, the aforementioned features are not taught or suggested by a combination of the *Davies* and *Krause* references.

A combination of *Davies* with *Krause* cannot support any rejection of claim 55 under 35 U.S.C. §103 as the references do not disclose all the elements of the claimed invention even when combined. Hence, claims 56 – 58 and 60 – 64 are likewise not obvious. Reconsideration of claims 55 – 58 and 60 – 64 is therefore requested.

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Based on the above amendments and these remarks, reconsideration of claims 32-37, 40-48, 50, 52-58, 61-64 is respectfully requested.

The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone.

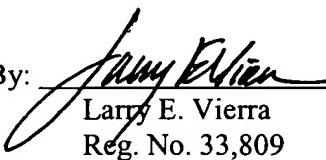
Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, November 7, 2003.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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By:



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